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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,442	09/30/2003	Russell F. Weymouth JR.	100-13A (CIP)	4119

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EXAMINER	
VARGOT, MATHIEU D	

ART UNIT	PAPER NUMBER
1732	

DATE MAILED: 09/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/674,442	WEYMOUTH, RUSSELL F.	
	Examiner	Art Unit	
	Mathieu D. Vargot	1732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-31 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-31 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 9/30/2003.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1.The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-9, 11, 12, 15, 16, 18-25, 27, 28 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laliberte et al (see col. 2, line 56 through col. 3, line 27; col. 4, line 55 through col. 5, line 3; Figs. 1 and 2).

Laliberte et al discloses the basic claimed method of hard coating a lens by maintaining a hard coat dip tank (124) at a temperature of 40-50 deg F, drying and heating the lens in a heated enclosure housing 12 (temperature of 90 deg F) and dipping the lens into the tank, wherein it is submitted that the temperature of the lens would be greater than that of the tank. Essentially, Laliberte et al fails to explicitly disclose that the temperature of the lens is within 20 deg F of the temperature of the tank. However, given that the lens would probably not be heated to the enclosure temperature unless the residence time therein would be very long, it is safe to say that the temperature of the lens is a less than 90 deg F when the lens is dipped in the hard coat tank. Given that the temperature of the lens would be around 70-80 deg F while in the enclosure and before the dipping, then the difference would be 20-30 deg F. It is submitted that one of ordinary skill in the art would have found the instant tank and lens temperature difference to have been obvious over Laliberte et al dependent on length of time the lens is within the enclosure. Clearly, the lens, by virtue of being in the enclosure (T = 90 deg F), would have a temperature greater than the hard coat dip tank (T = 40-50 deg F)

and the exact amount above this range would have been a parameter well within the skill level of the art. It is submitted that due to the ultrasonic cleaning and destaticizing steps, the lens would indeed acquire a temperature greater than that of the tank dip. At any rate, the key point is that Laliberte et al heats the hard coat dip tank and also the lens prior to its immersion therein, and that the lens is heated to a temperature greater than that of the tank. Laliberte et al discloses that the housing is connected to a dehumidifer so that the air therein is a dry environment. Certainly, the lens would have had to have been molded prior to coating same and storing the lens prior to coating would have been obvious. It is submitted that the exact temperatures employed for the lens, dry/reduced humidity environment and dip tank constitute result effective variables which would have been readily determined through routine experimentation. Drying resins prior to injection molding is nothing but conventional in the art and it is submitted that one of ordinary skill in this art would have found such an obvious modification to the process of Laliberte et al to reduce any bubbles or imperfections in the finished product. The exact dew point temperature of the drying environment and length of time the resin is heated therein would have been obvious features dependent on how much water is bound to the resin—ie, how hygroscopic it is.

2.Claims 10, 13, 14, 17, 26, 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laliberte et al in view of Farber et al.

Laliberte et al discloses the basic claimed process as set forth in paragraph 1, supra, the primary reference failing to teach the aspect of the dip tank containing a primer and the exact concentration of the primer. Farber et al discloses that plastic lenses are

conventionally primed before hard coating to improve the impact resistance of the lens so hard coated and teaches a water based polyurethane primer. It would have been obvious to one of ordinary skill in the art to have modified the dipping of Laliberte et al by employing a dip tank with a primer as generally taught by Farber et al to obtain a hard coated lens with an acceptable impact resistance. It is submitted that the exact concentration of the primer in the tank would have been an obvious feature dependent on the thickness desired for the primer layer. Using a water rinse to even out the primer is conventional in the art and would have been an obvious feature in the combination to form a more aesthetically pleasing lens.

3.The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-31 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of copending Application No. 10/430,035. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application and the copending one each set forth similar inventions of hard coating a plastic lens wherein

the lens is at a temperature greater than the dipping tank temperature. Any differences between the instant claims and those of the copending application are submitted to be either minor modifications which would have been obvious or are mere matters of semantics—ie, exactly how the claims are phrased, with really no differences in substance.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4.The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lamos et al discloses a thermal dryer mounted above the feed hopper of an extruder and teaches (see col. 1, lines 5-17) the need for drying resins prior to injection molding or extruding them.

5.Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mathieu D. Vargot whose telephone number is 571 272-1211. The examiner can normally be reached on Mon-Fri from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni, can be reached on 571 272-1196. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M. Vargot
September 17, 2004

M. Vargot
Mathieu D. Vargot
Primary Examiner
Art Unit 1732
9/17/04